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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,228	03/03/2004	Hui Suk Park	5873.38012	4785

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EXAMINER

DOAN, ROBYN KIEU

ART UNIT PAPER NUMBER

3732

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/792,228	Applicant(s) PARK, HUI SUK	
	Examiner Robyn Doan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-13 and 17-24 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/01/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 22 claimed "the thermoplastic glue between supplemental hair strands" which was not described in the specification at the time the application was filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the thermoplastic glue between supplemental hair strands" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Barrington (5107867).

With regard to claims 1-2, 6 and 10-12, Barrington discloses a method of attaching supplemental hair to natural human hair (figs. 1-5) comprising the steps of selecting a plurality of strands of human hair (28) growing from a scalp (col. 4, lines 11-13), directly contacting a cylindrical glued portion (20) of a supplemental hair bundle (22) with a heating element (34) and fusing the glued portion from a solidified state to a workable viscosity (col. 4, lines 40-44), wherein the supplemental hair bundle having a plurality of supplemental hair strands glued to one another at a glued portion by thermoplastic glue (col. 3, lines 62-68 and col. 4, lines 1-10), the thermoplastic glue liquifies and flows (col. 4, lines 50-53) therefore it inherently being between supplemental hair, clamping the glued portion of the supplemental hair bundle while in the solidified state to the selected plurality of strands of human hair using the heating element and allowing mixing of the thermoplastic glue with the human hair (col. 4, lines 38-53) and wherein the glue portion being distorted to force fused glue to contact and mix with the plurality of strands of human hair, forming a joint between the strand of

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human hair and the supplemental hair and directly contacting the joint with the heating element (figs. 4-5) which includes a heated jaw with a heating surface and a kneading jaw movably connected to the heated jaw; each of the jaws having a pivot end and a hinge connected to the pivoted ends (fig. 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 7-8, 13, 17-19 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrington in view of Undin (4048877).

With regard to claims 3-5, 7-8, 13, 17-19 and 21-24, Barrington discloses a method of attaching supplemental hair to natural hair comprising all the claimed limitations as discussed above except for the heating jaw having a channel and the kneading jaw having a kneading ridge, the length of the heating channel and the length of the kneading ridge being about .05 inches and the heating channel having a shape that matches a shape of the glue portion of the supplemental hair bundles. Undin discloses a pliers (fig. 1) comprising a first jaw (12) having a channel (40a) recessed in an inside surface of the jaw, a kneading jaw (22) including a kneading ridge (40b) moveably connected to the first jaw. It would have been obvious to one having an

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ordinary skill in the art at the time the invention was made to employ the pliers as taught by Undin in place of the heating tool of Barrington for the crimping purpose. . It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct for the heating channel length and the length of the kneading ridge being about .5 inches and the shape of the heating channel matches the shape of the glue portion of the supplemental hair bundles, since such modifications would have involved a mere change in the size and the shape of the component.

Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrington in view of Undin.

With regard to claims 9 and 20, Barrington in view of Undin , Barrington discloses a method of attaching supplemental hair to natural hair comprising all the claimed limitations as discussed above except for the step of applying heat along a length of a portion of half of a lateral face of the cylindrical glued portion and the heated jaw and the kneading jaw being coated with a material that resists sticking to thermoplastic glue. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the heated jaw and the kneading jaw being coated with a material that resists sticking to thermoplastic glue, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. And it would also have been an obvious matter of choice to apply heat along a length of a portion of half of a lateral face of the cylindrical glued portion for the intended use purpose.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 and 17-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6820625. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-13 and 17-24 of the application and claims 1-13 of the patent lies in the fact that the patent claims include many more elements and thus is more specific. Thus the invention of claims 1-13 is in effect a "species" of the "generic" invention of claims 1-13 and 17-24. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-13 and 17-24 are anticipated by claims 1-13 of the patent, it is not patentably distinct from claims 1-13.

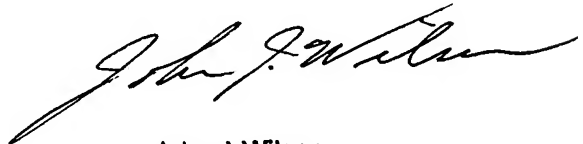
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan
June 13, 2005



John J. Wilson
Primary Examiner